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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,039

Applicant(s)

APPELMAN ET AL.

Examiner

MICHAEL E. KEEFER

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.4.7-77 and 90-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1.4.7-77 and 90-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8506)
Paper No(s)/Mail Date 2/12/2008, 10/16/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed 11/30/2007.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 45-76 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 45, the "computer readable medium," in accordance with Applicant's specification, may be a propagated signal (i.e. carrier waves). This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 46-55 which depend from claim 45 fail to remedy the deficiencies of claim 45 and thus are rejected for the same.

Regarding claim 56, the "computer readable medium," in accordance with Applicant's specification, may be a propagated signal (i.e. carrier waves). This subject matter is not limited to that which falls within a statutory category of invention because it

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is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 57-76 which depend from claim 56 fail to remedy the deficiencies of claim 56 and thus are rejected for the same.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4, 7-77 and 90-92 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment made to the independent claims contains matter not found in the original specification. Specifically, the limitation "migrating the accessed personalization item..." is not found to be disclosed in the originally filed specification or claims. In fact, the word migrating does not appear in the original specification at all.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 4, 7-77 and 90-92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Non-chat is used to define "instant messaging", As opposed to "chat". Applicant's specification does not shed any light upon what distinguishes "instant messaging" from "chat". To an ordinarily skilled artisan, these terms are synonymous; therefore, further definition as to how applicant is defining "instant messaging" as opposed to "chat" is required. The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 24, 42-45, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szeto in view of Belfiore (US 2002/0059425).

Regarding **claim 1**, Szeto discloses:

A user interface on a display that enables perception of communications that leverage a chat platform, the user interface comprising:

a module for rendering a chat application user interface for a chat communications session involving at least a first chat participant and a second chat participant, the user interface being presented at a system display presented to the second chat participant; (Fig. 9A/9B)

a module for receiving a personalization item presented to the system display and associated with an individual chat user the personalization item corresponding to an identifier obtained by a second chat participant system, the identifier enabling identification of a personalization item of the individual chat user; and (Fig. 2, <env 10> is sent as an identifier, Fig. 4 shows the retrieval of the environment using the identifier.)

a module for rendering the personalization item independently of a message used to obtain the identifier. (Fig. 2, <env 10> is sent as an identifier, Fig. 4 shows the retrieval of the environment using the identifier. Which renders the environment before dealing with the message that contained the identifier.)

Regarding **claim 24**, Szeto discloses:

A computer implemented method for enabling perception of a personalization item in a chat communications session, the method comprising:

storing on a host system one or more personalization items associated with a chat application operator;
receiving a request from a chat participant system for the personalization items associated with the chat application operator;

accessing the personalization items at the host system; and
communicating the personalization items from the host system to the chat participant system for rendering in a chat application running on the chat participant system. (These steps are disclosed in Fig. 6, which describes the environment site where environments are stored.)

Regarding **claim 42 as applied to claim 24**, Szeto discloses:

further comprising creating an identifier for a personalization item based upon the application of an algorithm to at least a portion of data comprising the item. (Szeto states that the "identifier corresponds to an environment". In order for this to be true, it is inherent that the identifier must have gone through an algorithm related to the data that it corresponds to, or else it could not correspond to the data.)

Regarding **claim 43 as applied to claims 24 and 42**, Szeto discloses:

further comprising determining if the personalization item is stored at the host system based upon the identifier; and, if the personalization item is stored at the host system, declining to redundantly store the personalization item at the host system. (Col. 5 lines 24-32, the user system (i.e. host system) will not redundantly store items in its cache.)

Regarding claim 44 as applied to claims 24 and 42-43, Szeto discloses:

further comprising determining whether the personalization item is an official item based upon the identifier; and displaying the personalization item if the personalization item is an official item. (Szeto, Col. 5 lines 17-20)

Regarding **claim 45**, Szeto discloses:

A computer program stored on a computer readable medium, the computer program comprising instructions for:

storing on a host system one or more personalization items associated with a chat application operator;

receiving a request from a chat participant system for the personalization items associated with the chat application operator;

accessing the personalization items at the host system; and

communicating the personalization items from the host system to the chat participant system for rendering in a chat application running on the chat participant system. (These steps are disclosed in Fig. 6, which describes the environment site where environments are stored (i.e. storing, receiving, accessing and communicating. Fig. 4 discloses rendering the communicated environment.)

Regarding **claim 77**, Szeto discloses:

A computer implemented method for enabling perception of a personalization item in a chat communications session, the method comprising:

rendering, on a chat message recipient system, a chat application user interface for a chat communications session involving at least one instant message recipient and a chat message sender;

receiving a message that includes a text message and personalization item to be displayed by the second chat participant when perceiving the text message,

the personalization item being selected by the instant message sender system; and

rendering the personalization item at the instant message recipient system when rendering another portion of the message. (Col. 10 lines 59-67 disclose sending parts of a message that are personalization items that are rendered on the users environment. (I.e. sending a message of cloud renders a cloud, or sending a ring function renders ringing on the user's environment.)

Szeto discloses all of the limitations of the claims above except for migrating personalization items from one context to another according to a mapping.

The general concept of migrating items from one context to another via mapping is well known in the art as taught by Belfiore. (See at least [0099] which discloses scaling and changing user interfaces when migrating programs in use between different devices, which requires a mapping between features to be displayed and what devices those features may be displayed in.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Setzo and the general concept of migrating items from one

context to another via mapping as taught by Belfiore in order to make the chat program more portable.

10. Claims 1, 4, 7-12, 14-15, 17-18, 20-23, 24-32, 34-35, 37-41, 45-48, 50-51, 53-55, 56-64, 66-67, 69, 71-76, 77, and 90-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles (US 5880731) in view of Belfiore.

Regarding **claim 1**, Liles discloses:

A user interface on a display that enables perception of communications that leverage a chat platform, the user interface comprising:

a module for rendering a chat application user interface for a chat communications session involving at least a first chat participant and a second chat participant, the user interface being presented at a system display presented to the second chat participant; (Fig. 13)

a module for receiving a personalization item presented to the system display and associated with an individual chat user the personalization item corresponding to an identifier obtained by a second chat participant system, the identifier enabling identification of a personalization item of the individual chat user; and (Col. 3 lines 27-30 ("personalization item"), an identifier is disclosed in col. 1, lines 50-65, col. 3 lines 19-21, 27-30.)

a module for rendering the personalization item independently of a message used to obtain the identifier. (Col. 1 lines 50-65, may be independent of message, col. 9 lines 53-55, 63-65)

Regarding **claim 2 as applied to claim 1**, Liles discloses:

The user interface of claim 1 in which the individual chat user comprises the first chat participant. (Liles, col 1 line 60 - col. 2 line 2)

Regarding **claim 3 as applied to claim 1**, Liles discloses:

The user interface of claim 1 in which the individual chat user comprises the second chat participant. (Liles, col 1 line 60 - col. 2 line 2)

Regarding **claim 4 as applied to claim 1**, Liles discloses:

in which the personalization item is rendered upon the occurrence of a change in a presence state of the individual chat user. (Liles, col. 1 lines 52-65, col 7 lines 7-16)

Regarding **claim 5 as applied to claims 1 and 4**, Liles discloses:

in which the individual chat user comprises the first chat participant. (Liles, col 1 line 60 - col. 2 line 2)

Regarding **claim 6 as applied to claims 1 and 4**, Liles discloses:

in which the individual chat user comprises the second chat participant. (Liles, col 1 line 60 - col. 2 line 2)

Regarding **claim 7 as applied to claim 1**, Liles discloses:

in which the identifier is obtained by receiving the identifier from a first chat participant system in a chat message. (Col. 2 lines 44-50)

Regarding **claim 8 as applied to claim 1**, Liles discloses:

in which the identifier is obtaining from a chat host system, the chat host system storing one or more identifiers associated with one or more personalization items for one or more chat users, the chat host system receiving an identity of the individual chat user and accessing an identifier associated with the individual chat user. (Col. 9

lines 5-15; in order to properly obtain and send the correct avatar (personalization item) the central server must store the identifiers of the users whose items are stored there, likewise, when retrieving the proper avatar, the server must receive the identity of the chat user (i.e. the identifier) and access that identifier to find the proper avatar.)

Regarding **claim 9 as applied to claim 1**, Liles discloses:

in which the identifier is obtained by retrieving the identifier from the second chat participant system. (Col. 9 lines 5-15, the identifier is retrieved from the list of identifiers in Fig. 13)

Regarding **claim 10 as applied to claim 1**, Liles discloses:

in which the identifier is obtained by retrieving the identifier from a remote data store. (Col. 5 lines 34-42)

Regarding **claim 11 as applied to claim 1**, Liles discloses:

in which the personalization item comprises a graphic. (Col. 1 lines 52-65)

Regarding **claims 12, 90 and 91 as applied to claims 1 and 11 and 77**, Liles discloses:

in which the graphic comprises an icon. (Col. 1 lines 52-65)

Regarding **claim 14 as applied to claim 1**, Liles discloses:

in which the personalization item comprises wallpaper (i.e. an image) capable of being rendered on a chat application user interface. (Col. 1 lines 52-65)

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Regarding **claim 15 as applied to claim 1**, Liles discloses:

in which the personalization item comprises an animation sequence. (Col. 2 lines 15-23, Col. 3 lines 20-26, 49-52)

Regarding **claim 17 as applied to claim 1**, Liles discloses:

in which the personalization item comprises a customized item provided by the first chat participant. (Col. 2 lines 24-28, 44-50; col 1 line 60 - Col. 2 line 2)

Regarding **claim 18 as applied to claim 1**, Liles discloses:

in which personalization item comprises a personalization item provided by a third party. (Col. 9 lines 5-15, the chat server is a 3rd party.)

Regarding **claim 20 as applied to claim 1**, Liles discloses:

in which the personalization item is configured to expire upon the occurrence of a predetermined event. (Col. 1 lines 62-65)

Regarding **claim 21 as applied to claims 1 and 20**, Liles discloses:

in which the predetermined event comprises passage of a predetermined length of time. (Col. 1 lines 62-65)

Regarding **claim 22 as applied to claims 1 and 20**, Liles discloses:

in which the predetermined event comprises passage of a predetermined date. (Col. 1 lines 62-65)

Regarding **claim 23 as applied to claims 1 and 20**, Liles discloses:

in which the predetermined event comprises a predetermined number of uses. (Col. 1 lines 32-35)

Regarding **claim 24**, Liles discloses:

A computer implemented method for enabling perception of a personalization item in a chat communications session, the method comprising:

storing on a host system one or more personalization items associated with a chat application operator; receiving a request from a chat participant system for the personalization items associated with the chat application operator; accessing the personalization items at the host system; and communicating the personalization items from the host system to the chat participant system for rendering in a chat application running on the chat participant system. (Col. 9 lines 4-15 discloses downloading a chat user's personalization item, and rendering it once it is retrieved.)

Regarding **claim 25 as applied to claim 24**, Liles discloses:

in which receiving the request comprises: receiving an identifier enabling identification of a personalization item associated with the chat application operator. (an identifier is disclosed in col. 1, lines 50-65, col. 3 lines 19-21, 27-30.)

Regarding **claim 26 as applied to claims 24**, Liles discloses:

in which receiving the request comprises receiving an identity of the chat participant; and accessing the personalization items comprises accessing the personalization items associated with the received identity. (Col. 9 lines 4-15

discloses downloading a chat user's personalization item, and rendering it once it is retrieved. In order to retrieve the correct personalization item (i.e. avatar) there must be an identifier indicating what user's avatar is desired.)

Regarding **claim 27 as applied to claims 24-25**, Liles discloses:

in which receiving the identifier further comprises receiving an identifier comprising a location on the host system of the personalization item. (Col. 6 lines 54-67)

Regarding **claim 28 as applied to claims 24-25 and 27**, Liles discloses:

in which the identifier further comprises an item type and a data size. (Col. 6 lines 54-67)

Regarding **claim 29 as applied to claims 24-25 and 27**, Liles discloses:

wherein the identifier further comprises one or more of a custom item flag, an official item flag, a banned item flag, and a redirect to different item flag. (Col. 3 lines 31-33 discloses a flag or representation (Col. 3 lines 18-20) that it is customized (Col. 8 line 62 - Col. 9 line 1)

Regarding **claim 30 as applied to claim 24**, Liles discloses:

in which the host comprises a server authorized as a partner to a chat host. (Col. 9 lines 4-15 disclose an authorized partner server which holds the avatars)

Regarding **claim 31 as applied to claim 24**, Liles discloses:

in which storing the personalization items comprises storing a graphic. (Col. 1 lines 52-65)

Regarding **claim 32 as applied to claims 24 and 31**, Liles discloses:

in which the graphic comprises an icon. (Col. 1 lines 52-65)

Regarding claim 34 as applied to claim 24, **Liles discloses:**

in which storing the personalization items comprises storing wallpaper (i.e. an image) capable of being rendered on a chat application user interface. (Col. 1 lines 52-65)

Regarding **claim 35 as applied to claim 24**, Liles discloses:

in which storing the personalization items comprises storing an animation sequence. (Col. 2 lines 15-23, Col. 3 lines 20-26, 49-52)

Regarding **claim 37 as applied to claim 24**, Liles discloses:

in which in which storing the personalization items comprises storing a personalization item configured to expire upon the occurrence of a predetermined event. (Col. 1 lines 62-65)

Regarding **claim 38 as applied to claims 24 and 37**, Liles discloses:

in which the predetermined event comprises passage of a predetermined length of time or the passage of a predetermined date. (Col. 1 lines 62-65)

Regarding **claim 38 as applied to claims 24 and 37**, Liles discloses:

in which the predetermined event comprises a predetermined number of uses. (Col. 1 lines 32-35)

Regarding **claim 38 as applied to claims 24 and 37**, Liles discloses:

further comprising: determining whether the personalization item has expired, and disallowing access to the personalization item if the personalization item has expired. (Col. 11 lines 36-67)

Regarding **claim 41 as applied to claim 24**, Liles discloses:

further comprising: determining whether the personalization item has been banned, and disallowing access to the personalization item if the personalization item has been banned. (Col. 11 lines 36-67)

Regarding **claim 45**, Liles discloses:

A computer program stored on a computer readable medium, the computer program comprising instructions for:

storing on a host system one or more personalization items associated with a chat application operator; receiving a request from a chat participant system for the personalization items associated with the chat application operator; accessing the personalization items at the host system; and communicating the personalization items from the host system to the chat participant system for rendering in a chat application running on the chat participant system. (Col. 9 lines 4-15 discloses downloading a chat user's personalization item, and rendering it once it is retrieved.)

Regarding **claim 46 as applied to claim 45**, Liles discloses:

in which instructions for receiving the request comprises instructions for receiving an identifier enabling identification of a personalization item associated with the chat application operator. (an identifier is disclosed in col. 1, lines 50-65, col. 3 lines 19-21, 27-30.)

Regarding **claim 47 as applied to claim 45**, Liles discloses:

in which instructions for receiving the request comprises instructions for receiving an identity of the chat participant; and instructions for accessing the personalization items comprises instructions for accessing the personalization items associated with the received identity. (Col. 9 lines 4-15 discloses downloading a chat user's personalization item, and rendering it once it is retrieved. In order to retrieve the correct personalization item (i.e. avatar) there must be an identifier indicating what user's avatar is desired.)

Regarding **claim 48 as applied to claim 45**, Liles discloses:

in which instructions for storing the personalization items comprises instructions for storing a graphic. (Col. 1 lines 52-65)

Regarding **claim 50 as applied to claim 45**, Liles discloses:

in which instructions for storing the personalization items comprises instructions for storing wallpaper (i.e. an image) capable of being rendered on a chat application user interface. (Col. 1 lines 52-65)

Regarding **claim 51 as applied to claim 45**, Liles discloses:

in which instructions for storing the personalization items comprises instructions for storing an animation sequence. (Col. 2 lines 15-23, Col. 3 lines 20-26, 49-52)

Regarding **claim 53 as applied to claim 45**, Liles discloses:

in which in which instructions for storing the personalization items comprises instructions for storing a personalization item configured to expire upon the occurrence of a predetermined event. (Col. 1 lines 62-65)

Regarding **claim 54 as applied to claims 45 and 53**, Liles discloses:

in which the predetermined event comprises passage of a predetermined length of time or the passage of a predetermined date. (Col. 1 lines 62-65)

Regarding **claim 55 as applied to claims 45 and 53**, Liles discloses:

in which the predetermined event comprises a predetermined number of uses. (Col. 1 lines 32-35)

Regarding **claim 56**, Liles discloses:

A computer program, stored on a computer readable medium, the computer program comprising instructions for:

rendering, on a first chat participant system, a chat application user interface for a chat communications session involving at least an intended second chat participant and a first chat participant; and (Fig. 13)

rendering at the first chat participant system, a personalization item associated with the second chat participant prior to communication with the intended second chat participant system. (Col. 9 lines 5-15 disclose downloading and rendering personalization items without any communication between the users)

Regarding **claim 57 as applied to claim 56**, Liles discloses:

in which instructions for rendering at the first chat participant system comprises instructions for rendering at the first chat participant system prior to communication of a chat message with the intended second chat participant system. (Col. 9 lines 5-

15 disclose downloading and rendering personalization items without any communication between the users)

Regarding **claim 58 as applied to claim 56**, Liles discloses:

in which instructions for rendering at the first chat participant system comprises instructions for rendering at the first chat participant system before a communications session is established with the intended second chat participant system. (Col. 9 lines 5-15 disclose downloading and rendering personalization items without any communication between the users)

Regarding **claim 59 as applied to claim 56**, Liles discloses:

in which instructions for rendering at the first chat participant system comprises instructions for rendering at the first chat participant system before the first chat participant system sends a message to the intended second chat participant system. (Col. 9 lines 5-15 disclose downloading and rendering personalization items without any communication between the users)

Regarding **claim 60 as applied to claim 56**, Liles discloses:

in which instructions for rendering at the first chat participant system comprises instructions for rendering at the first chat participant system before the first chat participant system receives a message from the intended second chat participant system. (Col. 9 lines 5-15 disclose downloading and rendering personalization items without any communication between the users)

Regarding **claim 61 as applied to claim 56**, Liles discloses:

further comprising instructions for: associating the identifier with the personalization item; obtaining the personalization item from a source other than a message used to obtain the identifier; and rendering the personalization item at the first chat participant system. (Col. 9 lines 5-15 disclose downloading and rendering personalization items without any communication between the users, and from somewhere other than the message with the identifier)

Regarding **claim 62 as applied to claim 56**, Liles discloses:

in which instructions for obtaining the identifier comprises instructions for: sending an identity of the intended second chat participant to a chat host system, the chat host system storing one or more identifiers associated with one or more personalization items for the intended second chat participant; and receiving an identifier associated with the individual intended second chat participant in a message from the chat host system. (Col. 9 lines 5-15)

Regarding **claim 63 as applied to claim 56**, Liles discloses:

in which instructions for obtaining the identifier comprises instructions for locating the identifier at the intended second chat participant system. (Col. 6 lines 54-67)

Regarding **claim 64 as applied to claim 56**, Liles discloses:

in which instructions for obtaining the identifier comprises instructions for retrieving the identifier from a remote data store. (Col. 5 lines 34-42)

Regarding **claim 66 as applied to claim 56**, Liles discloses:

in which instructions for obtaining the personalization item comprises instructions for obtaining a graphic. (Col. 1 lines 52-65)

Regarding **claim 67 as applied to claim 56**, Liles discloses:

in which instructions for obtaining the personalization item comprises instructions for obtaining wallpaper (i.e an image) capable of being rendered on a chat application user interface. (Col. 1 lines 52-65)

Regarding **claim 69 as applied to claim 56**, Liles discloses:

in which instructions for obtaining the personalization item comprises instructions for obtaining an animation sequence. (Col. 2 lines 15-23, Col. 3 lines 20-26, 49-52)

Regarding **claim 71 as applied to claim 56**, Liles discloses:

in which instructions for obtaining the personalization item comprises instructions for obtaining a customized binary object provided by the intended second chat participant. (Col. 2 lines 24-28, 44-50; col 1 line 60 - Col. 2 line 2)

Regarding **claim 72 as applied to claim 56**, Liles discloses:

in which instructions for obtaining the personalization item comprises instructions for obtaining a personalization item configured to expire upon the occurrence of a predetermined event. (Col. 1 lines 62-65)

Regarding **claim 73 as applied to claims 56 and 72**, Liles discloses:

in which the predetermined event comprises passage of a predetermined length of time or on passage of a predetermined date. (Col. 1 lines 62-65)

Regarding **claim 74 as applied to claims 56 and 72**, Liles discloses:

in which the predetermined event comprises a predetermined number of uses. (Col. 1 lines 32-35)

Regarding **claim 75 as applied to claims 56 and 72**, Liles discloses:

further comprising instructions for: determining whether the personalization item has expired, and disallowing display of the personalization item if the personalization item has expired. (Col. 1 lines 62-65)

Regarding **claim 76 as applied to claim 56**, Liles discloses:

further comprising instructions for: determining whether the personalization item has been banned, and disallowing display of the personalization item if the personalization item has been banned. (Col. 1 lines 62-65)

Regarding **claim 77**, Liles discloses:

A computer implemented method for enabling perception of a personalization item in a chat communications session, the method comprising:

rendering, on a chat message recipient system, a chat application user interface for a chat communications session involving at least one instant message recipient and a chat message sender; (Fig. 13)

receiving a message that includes a text message and personalization item to be displayed by the second chat participant when perceiving the text message, the personalization item being selected by the instant message sender system; and rendering the personalization item at the instant message recipient

system when rendering another portion of the message. (Col. 9 lines 55-60 discloses sending a personalization item (i.e. a gesture) with a message, which then is rendered by the recipient of the message.)

Regarding **claim 78 as applied to claim 77**, Liles discloses:

in which receiving the message comprises receiving personalization item automatically selected by the instant message sender system. (Col. 9 lines 16-32 discloses sending a personalization item (i.e. a gesture) automatically, which then is rendered by the recipient of the message.)

Regarding **claim 79 as applied to claim 77**, Liles discloses:

in which receiving the message comprises receiving at least a portion of the personalization item in a chat message from a chat message sender system. (Col. 9 lines 55-60 discloses sending a personalization item (i.e. a gesture) with a message, which then is rendered by the recipient of the message.)

Regarding **claim 80 as applied to claim 77**, Liles discloses:

in which receiving the message comprises receiving at least a portion of the personalization item in a message generated upon a change in a presence state of the first chat participant. (Liles, col. 1 lines 52-65, col 7 lines 7-16)

Regarding **claim 81 as applied to claim 77**, Liles discloses:

in which receiving the message comprises receiving in the message at least a portion of personalization item provided by a host other than a chat message host. (Col. 9 lines 55-60 discloses sending a personalization item (i.e. a

gesture) with a message from a user (i.e. a source other than the chat host), which then is rendered by the recipient of the message.)

Regarding **claim 83 as applied to claim 77**, Liles discloses:

in which receiving the message comprises receiving at least a portion of personalization item configured to expire upon the occurrence of a predetermined event. (Col. 1 lines 62-65)

Regarding **claim 84 as applied to claims 77 and 83**, Liles discloses:

in which the predetermined event comprises passage of a predetermined length of time or passage of a predetermined date. (Col. 1 lines 62-65)

Regarding **claim 85 as applied to claims 77 and 83**, Liles discloses:

in which the predetermined event comprises a predetermined number of uses. (Col. 1 lines 32-35)

Regarding **claim 86 as applied to claims 77 and 83**, Liles discloses:

further comprising: determining whether the personalization item has expired based on determining whether the predetermined event has occurred, and disallowing display of the personalization item if the personalization item has expired. (Col. 1 lines 62-65)

Regarding **claim 87 as applied to claim 77**, Liles discloses:

further comprising: determining whether the personalization item has been banned, and disallowing display of the personalization item if the personalization item has been banned. (Col. 1 lines 62-65)

Regarding **claim 88 as applied to claims 77 and 87**, Liles discloses:

in which determining whether the personalization item has been banned comprises determining whether the personalization item has been banned based on a report by a user. (Col. 1 lines 62-65, the user reports that they are leaving the chat room, so their avatar is no longer displayed (i.e. banned))

Regarding **claim 89 as applied to claims 77 and 87**, Liles discloses:

in which determining whether the personalization item has been banned comprises determining whether the personalization item has been banned based on a violation of a term of service agreement. (Col. 1 lines 62-65, if a user is kicked from the chatroom, they are leaving the chat room, so their avatar is no longer displayed (i.e. banned))

Liles discloses all of the limitations of the claims above except for migrating personalization items from one context to another according to a mapping. The general concept of migrating items from one context to another via mapping is well known in the art as taught by Belfiore. (See at least [0099] which discloses scaling and changing user interfaces when migrating programs in use between different devices, which requires a mapping between features to be displayed and what devices those features may be displayed in.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Liles and the general concept of migrating items from one context to another via mapping as taught by Belfiore in order to make the chat program more portable.

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11. Claims 13, 16, 33, 36, 49, 52, 68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles and Belfiore as applied to claims 1, 24, 45, and 56 above, and further in view of Grayson et al. (US 5963217), hereafter Grayson.

Liles and Belfiore teach all of the limitations of claims 13, 16, 33, 36, 49, 52, 68, and 70 except that the item transported is sound or a video clip.

The general concept of transporting sound or video clips in a chat environment is well known in the art as taught by Grayson. (Col. 9 lines 27-35, 37-57, Col. 9 line 63-Col. 10 line 5)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Liles and Belfiore with the general concept of transporting sound or video clips in a chat environment as taught by Grayson in order to reduce the bandwidth of transferring digital audio over the network by transmitting video and/or audio over the network between chat users in an electronic chat session environment.

12. Claims 13, 16, 33, 36, 49, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szeto and Belfiore as applied to claims 1, 24, and 45 above, and further in view of Grayson.

Szeto and Belfiore teach all of the limitations of claims 13, 16, 33, 36, 49, and 52 except that the item transported is sound or a video clip.

The general concept of transporting sound or video clips in a chat environment is well known in the art as taught by Grayson. (Col. 9 lines 27-35, 37-57, Col. 9 line 63-Col. 10 line 5)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Szeto and Belfiore with the general concept of transporting sound or video clips in a chat environment as taught by Grayson in order to reduce the bandwidth of transferring digital audio over the network by transmitting video and/or audio over the network between chat users in an electronic chat session environment.

13. Claims 19 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles and Belfiore as applied to claims 1, 18, 77, and 81 above, and further in view of Ronen (US 5745556).

Liles and Belfiore teach all of the limitations of claims 19 and 82 except for only rendering the items in consideration of payment.

The general concept of only providing services to upon payment is well known in the art as taught by Ronen. (See Abstract and Fig. 7)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Liles and Belfiore and the general concept of only providing services to upon payment is well known in the art as taught by Ronen in order to allow avatar providers to be paid for the use of their avatars.

14. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liles and Belfiore as applied to claim 56 above, and further in view of Chase et al. (US 5944780), hereafter Chase.

Liles and Belfiore teach all the limitations of claim 65 except for attempting to access the personalization items from a different server if the first server attempted does not have the identified item.

Chase teaches:

determining whether the personalization item associated with the received identifier is available at the first chat participant system; (Fig. 3, steps 34-35, Col. 6 line 64-Col. 7 line 6)

retrieving the personalization item from the first chat participant system if the personalization item is available at the first chat participant system; and (Fig. 3 step 37, Col. 7 lines 5-6)

requesting the personalization item from a remote source and receiving the personalization item from the remote source at the first chat participant system if the personalization item is not available at the first chat participant system. (Fig. 3 steps 300-306, Col. 7, lines 6-61)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Liles and Belfiore with the teachings of Chase in order to reduce latency avoid congestion and maintain coherency of shared data.

Response to Arguments

15. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant asserts that the claims comply with 35 U.S.C. 101. The Examiner disagrees, as the "computer readable storage medium" claimed in claims 45 and 56 still maps back to a "propagated signal" in the specification on pages 5, 8, and 13. In order to overcome this rejection, the Examiner recommends an amendment to the specification on pages 5 8 and 13 indicating that a "computer

readable storage medium" is only those media that are statutory, and defining that the propagated signals as a different term, therefore clearly stating that the claimed "computer readable storage medium" is not a propagated signal. (Merely deleting the propagated signal from the specification would constitute new matter by deletion.)

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL E. KEEFER whose telephone number is (571)270-1591. The examiner can normally be reached on Monday through Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 3/1/2008

/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2154